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PATENT
Attorney Docket No. 29337/PP509A

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Willat *et al.*

Serial No. 10/798,663

Filed: March 11, 2004

For: Writing Implement Having Deformable Grip

Group Art Unit: 3676

Examiner: Mark A. Williams

I hereby certify that this paper is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this date:

August 25, 2006

Andrew M. Lawrence, Reg. No. 46,130
Attorney for Applicants

RESPONSE TO RESTRICTION REQUIREMENT DATED JULY 25, 2006

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This paper is filed in response to the official action dated July 25, 2006 (the official action), wherein a restriction requirement was imposed. This response is timely filed.

RESTRICTION REQUIREMENT

The official action requires election of a single claim group from the following two groups:

Group I: claims 54-63, which are drawn to a writing instrument; and,

Group II: claims 64-69, which are drawn to a method of forming a tubular sleeve on a writing instrument.

See official action at page 2.

The restriction requirement is respectfully traversed. Reconsideration and withdrawal of the restriction requirement are respectfully requested in view of the following remarks.

The restriction requirement is improper and should be withdrawn.

The standard for properly requiring restriction among claim groups includes two prongs. First, the claimed inventions must be independent or distinct; and, second, there must be a serious burden on the examiner if restriction is required. M.P.E.P. §803 states:

> If the search and examination of an entire application can be made without serious burden, the examiner *must* examine it on the merits, even though it includes claims to distinct or independent inventions.

(emphasis added).

Assuming *arguendo* that the claims as grouped by the Patent Office are "independent" or "distinct," the restriction requirement is nonetheless improper, because the Patent Office has failed to demonstrate that "a serious burden" will result if restriction is not required. *See* M.P.E.P. §803. No such burden has been alleged in the official action.

Moreover, removal of the restriction requirement will conserve the resources of the Patent Office and the applicants by minimizing the number of similar searches performed by Patent Office examiners and by reducing the filing fees and prosecution costs of the applicants. The relationship between Groups I and II and the similarity of the recited limitations strongly suggests that the searches required for Groups I and II will be similar, if not identical. Thus, if the restriction requirement is maintained, the applicants will likely incur additional prosecution costs associated with filing a divisional application, and the Patent and Trademark Office will likely be required to perform a duplicative search of the same prior art. Accordingly, the withdrawal of the restriction requirement will lessen the burden on the Patent Office and on the applicants.

Furthermore, restricting the claims *at this point* of the proceedings is *prejudicial* to the applicants because any patent issued from a divisional application will experience a reduced term in view of the PTO's delay in requiring restriction.

For these reasons, the restriction requirement imposed in the official action should be withdrawn.

PROVISIONAL ELECTION

Pursuant to the requirements of 37 C.F.R. § 1.143, the applicants elect Group I (claims 54-63) for continued prosecution in this application, with traverse.

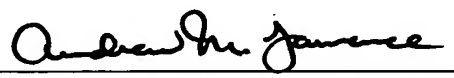
CONCLUSION

It is submitted that the application is in condition for allowance. Should the examiner wish to discuss the foregoing, or any matter of form or procedure in an effort to advance this application to allowance, he is respectfully invited to contact the undersigned attorney at the indicated telephone number.

Respectfully submitted,

MARSHALL, GERSTEIN & BORUN LLP

August 25, 2006



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